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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,779	08/06/2003	Tetsuya Otosaka	SH-0037US	7630
21254	7590	05/09/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			IVEY, ELIZABETH D	
		ART UNIT		PAPER NUMBER
				1775

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/634,779	OTOSAKA ET AL.
	Examiner Elizabeth Ivey	Art Unit 1775

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 August 2003.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 and 20-23 is/are pending in the application.  
 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 and 20-23 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 06 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JENNIFER MCNEIL  
PRIMARY EXAMINER

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 20-23, drawn to an optical fiber preform and fiber, classified in class 428, subclass 542.8
- II. Claims 11-19, drawn to a method of manufacturing a preform, classified in class 65, subclass 385

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the optical fiber preform can be made by sol gel method.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. During a telephone conversation with Philip Miller on March 28, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10 and 20-23. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 11-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Neither the independent claim 1 nor dependent claim 2 upon which claim 7 depends refers to "a clad". For claim 8 to define a clad in no way further limits claim 2 and is therefore in improper dependent form. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-2, 6-10, and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2, 6-9 and 20-23 are indefinite since they recite functional limitations without any accompanying compositional limitations. *Ex parte SLOB 157 USPQ 172 (1967).*

*Claims merely setting forth physical characteristics desired in [sic] article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague and indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which impart desired characteristics. Ex parte SLOB 157 USPQ 172 (1967).*

Regarding claims 1-2, 6-9 and 20-23, the claims provide no structure or composition and set forth only desired viscosity characteristics. Regarding claims 21-23 the claims provide no structure or composition and set forth only desired transmission loss characteristics.

Additionally, regarding claims 1 and 20, it is unclear whether the applicant is claiming the preform or the optical fiber as the characteristics claimed are in reference to both the preform and the optical fiber in both claims 1 and 20. Claim 1 is confusing as to what property is being claimed. Lines 3-7 are not clearly worded. Regarding claim 20, it is not clear how the limitations of the preform (properties) would define the final product over a final product made from another preform.

Additionally, regarding claim 8, the claim recites the limitation "wherein the outermost clad layer" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 10, it is unclear what the term portion is referring to. It is also unclear what constitutes an "appropriate combination" of forming methods.

Additionally, regarding claim 21, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 21 recites the broad recitation equal to or less than .35 dB/km, and the claim also recites equal to or less than .30dB/km, which is the narrower statement of the range/limitation.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,067,793 to Bachmann et al.

Regarding Claims 1-4 and 6-9, Bachmann discloses a solid preform for drawing an optical fiber having a core and a multiple number of claddings. Bachmann discloses an outer tube of quartz glass manufactured from quartz crystals, a first layer (inside the tube) of synthetic quartz glass (column 3 lines 12-30). The viscosities and radial viscosity distributions are properties inherent to the materials. A chemical composition and its properties are inseparable. *MPEP 2112.02*. Because the prior art exemplifies the applicant's claimed composition in relation to the quartz glass, the claimed physical property relating to the viscosity is inherently present in the prior art. Absent an objective evidentiary showing to the contrary, the addition of the claimed physical property to the claim language fails to provide patentable distinction over the prior art.

Regarding claim 10, claim 10 is a product by process claim wherein the patentability of the product does not depend on its method of production. "If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *See MPEP 2113*. Absent an evidentiary showing of criticality resulting in unexpected results between the claimed invention and the prior art. As such, the process limitation within claim 10 does not provide patentable distinction over the prior art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,067,793 to Bachmann et al in view of U.S. Patent Re. 30,883 to Rau et al. Bachmann discloses an optical fiber preform wherein a quartz inner clad layer is doped with at least one of the dopants consisting essentially of chlorine, germanium, fluorine or phosphorous. Bachmann specifically mentions germanium and fluorine (column 3 lines 19-29). Bachmann does not specifically disclose the doped layers to be a synthetic quartz glass. Rau discloses the use of a

covering of doped synthetic quartz glass to obtain a foreproduct, or preform, in the manufacture of light conducting fibers (optical fibers) (column 2 lines 39-43) and suggests it is particularly useful for the manufacture of fibers whose core consists of quartz glass of high purity (column 3 lines 35-37). Bachmann teaches the importance of having minimal dispersion and low losses and the describes use of dopants to obtain “the ultimate preform” with specifically varied refractive index layers (column 3 lines 30 – 36). Because Rau teaches a synthetic quartz glass whose index of refraction can be varied in a prescribed manner with the use of dopants (column 2 lines 11-32), it would be obvious to a person having ordinary skill in the art at the time of the invention to use the synthetic doped quartz glass of Rau as the doped quartz of Bachmann.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure. US Patent 6,776,012 B2 to Chang et al. shows an optical fiber with low transmission loss at 1385 nm, US Patent 6,622,527 to Schotz et al. shows the use of synthetic quartz layers in fiber optic preform fabrication, U.S. Patent 6,116,055 to Ishikawa et al. shows the doping of synthetic glass with chlorine for use in optical fiber preforms, U.S. Patent Application US 2002/0136515 to Schaper et al. shows the doping of synthetic quartz glass for fiber optic applications, U.S. Patent Application US 2003/0024276 A1 to Anderson et al. shows glass for fiber optics doped with phosphorous, chlorine, fluorine and germanium, U.S. Patent Application US 2002/0170320 A1 to Schotz et al. shows an optical fiber preform made from synthetic quartz glass.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Ivey whose telephone number is (571) 272-8432. The examiner can normally be reached on 7:00- 4:30 M-Th and 7:00-3:30 alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Elizabeth D. Ivey*  
Elizabeth D. Ivey  
*JM*  
JENNIFER MCNEIL  
PRIMARY EXAMINER